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In re Application of: :  
LIATARD, Yves, et al. : DECISION  
U.S. Application No.: 10/507,244 :  
PCT No.: PCT/FR2002/000883 :  
International Filing Date: 12 March 2002 :  
Priority Date: None :  
Atty Docket No.: 4444-044 :  
For: DEVICE FOR SURFACE :  
TREATMENT OF OBJECTS WITH :  
REDUCED SIZE AND IMPROVED :  
ERGONOMICS :  
:

This decision is issued in response to the "Resubmission Of Response to Notice Of Missing Requirements" filed 10 January 2006, treated herein as a petition under 37 CFR 1.8(b) to confirm the timely filing of a response to the Notification Of Missing Requirements, as well as the "Request For Corrected Filing Receipt" filed 12 April 2006 and the "Request For Refund" filed 20 September 2006. No petition fee is required.

**BACKGROUND**

On 12 March 2002, applicants filed international application PCT/FR2002/000883. The international application did not claim an earlier priority date, and it designated the United States. On 18 September 2003, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the international filing date, i.e., 12 September 2004.

On 10 September 2004, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 25 February 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that a properly executed oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing this declaration later than thirty months after the priority date, and additional claims fees were required were required.

On 10 January 2006, applicants filed the “Resubmission Of Response to Notice Of Missing Requirements” considered herein. This submission asserts that, on 14 March 2005, applicants filed via facsimile a response to the Notification Of Missing Requirements that included a preliminary amendment removing multiple dependent claims, an executed declaration, and a credit card payment for the required late-declaration surcharge. Copies of the materials purportedly filed on 14 March 2005 are included with applicants’ 10 January 2006 submission.

On 08 February 2006, the DO/EO/US mailed a Notification Of Acceptance (Form PCT/DO/EO/903) indicating that the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) were satisfied on 10 January 2006. On the same date, the USPTO mailed a filing receipt identifying the 35 U.S.C. 371(c) date as 10 January 2006.

On 12 April 2006, applicants filed the “Request For Corrected Filing Receipt” considered herein. This submission requests that the 35 U.S.C. 371(c) date be corrected to 14 March 2005, the date on which the response to the Notification Of Missing Requirements was purportedly first filed.

On 20 September 2006, applicants filed the “Request For Refund” considered herein. This submission asserts that applicants were charged the \$65 late-declaration surcharge twice, and requests a refund of the duplicative fee.

## DISCUSSION

### **1. Petition Under 37 CFR 1.8(b)**

The application file does not contain the “Response To Notification Of Missing Requirements” and accompanying materials purportedly filed via facsimile on 14 March 2005.<sup>1</sup> The earliest copies of such materials present in the application file are the copies included with the “Resubmission Of Response to Notice Of Missing Requirements” filed 10 January 2006 (hereinafter “Resubmission”).

The filing date of the Resubmission is later than the extendable deadline provided by the Notification Of Missing Requirements mailed 25 February 2005. Accordingly, in order for these materials to be considered a timely response to the Notification of Missing Requirements, as required to avoid abandonment, applicants must provide an acceptable showing that the materials were originally filed on 14 March 2005, as claimed.

Where, as here, applicant seeks to have missing correspondence filed by facsimile treated as timely filed, the applicable regulation is 37 CFR 1.8(b) (see MPEP section 512). 37 CFR 1.8(b) states the following:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in

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<sup>1</sup> USPTO records do show that payment of the \$65 surcharge for filing the declaration later than thirty months after the priority date was received on 14 March 2005.

the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed or decided with prejudice, ... the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission, or submission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement. ...

With respect to item (1) above, the "Resubmission" was filed promptly after applicant became aware that the USPTO did not have evidence of receiving the original correspondence. Item (1) is therefore satisfied.

With respect to item (2) above, the present petition includes a copy of the previously transmitted correspondence, the first page of the correspondence itemizes the enclosed materials and bears a "Certification Of Facsimile Transmission." Item (2) is therefore satisfied.

With respect to item (3) above, the Resubmission includes a statement by counsel Allan M. Lowe that the Response to Notice of Missing Requirements and Preliminary Amendment were filed by facsimile on March 14 2005. However, Mr. Lowe is not the person who signed the "Certificate Of Facsimile Transmission" contained on the original correspondence. Section 512 of the MPEP states the following: "If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission." The Resubmission does not include a statement by Mr. Lowe explaining how he has firsthand knowledge of the previous transmission. Moreover, although the Resubmission states that "a copy of the fax confirmation" is included, the application file does not include a copy of such fax confirmation.

Based on the above, the Resubmission does not satisfy the requirement of 37 CFR 1.8(b)(3). Accordingly, on the present record it cannot be concluded that the declaration and preliminary amendment included with the present petition were originally filed by facsimile on 14 March 2005 as a timely response to the Notification Of Missing Requirements.

It is noted that, absent a supplemental showing that satisfies the requirements of 37 CFR 1.8(b)(3), the present application will be considered abandoned for failure to file a timely response to the Notification Of Missing Requirements mailed 25 February 2005.

## 2. Request For Corrected Filing Receipt

The Request For Corrected Filing Receipt asserts that the materials included with the Resubmission was originally filed on 14 March 2005 filing date and that the 35 U.S.C. 371(c) date herein should therefore be corrected to 14 March 2005. However, as noted above, the earliest copy of the materials purportedly filed on 14 March 2005 present in the application file are those included with the Resubmission filed 10 January 2006. Should applicant make an acceptable showing under 37 CFR 1.8(b) (see discussion above), these materials can be treated as a timely response to the Notification of Missing Requirements pursuant to 37 CFR 1.8(a). However, as set forth in 37 CFR 1.8(a), the “actual date of receipt will be used for all other purposes.” Thus, even if the materials included with the Resubmission are treated as timely filed under 37 CFR 1.8, the filing date for such materials for all other purposes, including the according of a date under 35 U.S.C. 371(c), is 10 January 2006, that is, the actual date of receipt of the first copy of such materials present in the application file. Applicants’ request to have such materials accorded a filing date of 14 March 2005 is therefore appropriately dismissed.

## 3. Request For Refund

The Request for Refund seeks a refund of duplicative charges made by the USPTO for the \$65 surcharge required for filing the declaration later than thirty months after the priority date. A review of the application file confirms that applicants were improperly charged more than once for this surcharge; however, USPTO records show that these duplicative charges were subsequently refunded to applicant. The Request For Refund is therefore now moot.

## 4. English Translation Of The International Application

A review of the English translation of the international application filed by applicants on 10 September 2004 reveals that this translation is defective. Specifically, applicants have not provided a translation into English of the nine original claims filed with the international application (instead, applicants have provided an English translation containing eight claims, which corresponds to the number of claims contained in the international application as amended under PCT Article 19). See MPEP section 1893.01(d):

The translation must be a translation of the international application as filed or with any changes which have been properly accepted under PCT Rule 26 or any rectifications which have been properly accepted under PCT Rule 91. A translation of less than all of the international application (e.g., a translation that fails to include a translation of text contained in the drawings or a translation that includes a translation of claims amended under PCT Article 19 or 34 but does not include a translation of the original claims) is unacceptable.

Applicants are required to provide an English translation of the original nine claims contained in the international application as filed. In addition, applicants must submit the processing fee for filing the English translation later than thirty months after the priority date.

**CONCLUSION**

The petition to confirm that the materials included with the "Resubmission Of Response to Notice Of Missing Requirements" filed 10 January 2006 were originally filed on 14 March 2005 as a timely response to the Notification of Missing Requirements is **DISMISSED** without prejudice.

The "Request For Corrected Filing Receipt" filed 12 April 2006, which requested that the 35 U.S.C. 371(c) date be corrected to 14 March 2005, is **DISMISSED** without prejudice.

The "Request For Refund" filed 20 September 2006 is **DISMISSED AS MOOT** based on the previous refund of the requested fees.

The English translation of the international application filed 10 September 2006 is defective for failure to include an English translation of the nine original claims contained in the international application.

The "Notification of Acceptance" (Form PCT/DO/EO/903) and filing receipt mailed 08 February 2006, based as they were on applicants' purported satisfaction of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) on 10 January 2006, are hereby **VACATED**.

Any request for reconsideration of the present decision must be filed within **TWO (2) MONTHS** of the mail date of the present decision and must include a proper response, that is, (1) the materials required to satisfy 37 CFR 1.8(b)(3), as discussed above and in the MPEP; and (2) an English translation of the nine original claims contained in the international application.

Failure to file a timely and proper response will result in abandonment of the application. Extensions of time are available under 35 U.S.C. 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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